PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	
Jean-Marc ASCIONE *et al.*	Group Art Unit: 1751
Application No.: 09/881,807	Examiner: E. B. Elhilo
Filed: June 18, 2001	Confirmation No.: 8671
For: COMPOSITIONS COMPRISING A CATIONIC HOMOPOLYMER AND THEIR USE FOR STABILIZATION OF AN OXIDIZING SOLUTION	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER BOARD RULE § 41.41

Pursuant to Board Rule 37 C.F.R. § 41.41, Appellants present a Reply Brief to the Examiner's Answer dated September 9, 2005. This Reply Brief is due by November 9, 2005, and is timely. A Request for Oral Hearing is filed concurrently with this Brief.

Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

In response to Appellants' Appeal Brief filed June 23, 2005, the Office maintains its position that claims 1-2, 6-31, 40-48, 52-57, 61-86, 95-103, 107-112, 116-141, 150-158 and 162-168 are unpatentable under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 6,315,989 to Narasimhan et al. ("*Narasimhan*") in view of U.S. Patent No. 5,735,908 to Cotteret et al. ("*Cotteret*"); and that claims 32-39, 49-51, 87-94, 104-106, 142-149 and 159-161 over the combination of *Narasimhan* in view of *Cotteret* and further in view of U.S. Patent No. 6,156,076 to Casperson et al. ("*Casperson*"). *See generally* Examiner's Answer dated September 9, 2005. Appellants respectfully continue to disagree for the reasons of record, as emphasized below.

The Office's characterization of the teachings of *Narasimhan* and *Cotteret* creates the impression that all that is required to arrive at the claimed invention is to take the polyquaternium-37 taught by *Cotteret* and substitute it into a composition taught by *Narasimhan* that already combines the remaining claimed components (b)-(e). *See* Examiner's Answer, pages 3-4. As discussed in detail in the Appeal Brief filed June 23, 2005, this characterization oversimplifies the teachings of the references, disregards the need to pick and choose from optional composition components, and requires the selection of non-preferred embodiments for the Office's proposed substitution. For the requisite motivation to combine, the Office argues that Narasimhan "suggests the use of cationic polymers" and that Cotteret teaches polyquaternium-37, a cationic homopolymer, and concludes that the teaching of a genus by one reference and of a species within the genus by another reference is sufficient to motivate the ordinary artisan to substitute the species. *See* Examiner's Answer, page 5.

As the Federal Circuit has noted, however, "virtually all [inventions] are combinations of old elements." *See, e.g., In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). But the Federal Circuit in *Rouffet* went on to explain that even though very often an examiner may find every element of a claimed invention in the prior art, the mere identification is not sufficient to negate patentability. *Id.*, 47 U.S.P.Q.2d at 1457. Instead, the court stated that "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.*, 47 U.S.P.Q.2d at 1457.

Appellants again respectfully submit that here the Office has not provided any reasons that the skilled artisan would select claimed components (b)-(e) from the various laundry lists taught in *Narasimhan*, as detailed in the Appeal Brief. Further, even assuming for the sake of argument that the skilled artisan did somehow make those selections, the Office also has not provided any reasons why the artisan would then select the cationic homopolymer polyquaternium-37 from the teachings of *Cotteret* and substitute it into the composition of *Narasimhan*. *Cotteret* teaches that polymers which are <u>not</u> cationic homopolymers comprising repeating units of formula (I) are preferred in *Cotteret*'s compositions. *See* col. 3, line 65 to col. 4, line 55. Nothing in *Narasimhan*, *Cotteret*, or the Office's rejection suggests that a cationic homopolymer comprising repeating units of formula (I) in general, or polyquaternium-37 in particular, would be desirably included in a composition comprising at least one fatty alcohol, at least one alkoxylated fatty alcohol, at least one fatty amide, and at least one oxidizing

agent as claimed. Further, because *Casperson* does not remedy the deficiencies present in the teachings of the primary references, its teaching of individual species of alkoxylated fatty alcohols and fatty amides is irrelevant.

For the reasons of record and the reasons set forth above, Appellants maintain that the Office has not established a *prima facie* case of obviousness based on the combinations of *Narasimhan* in view of *Cotteret*, or *Narasimhan* in view of *Cotteret* and further in view of *Casperson*. In particular, the Office fails to provide any reasons that one of ordinary skill in the art would have been motivated to make the Office's proposed selections and substitutions. Accordingly, Appellants respectfully submit those rejections are in error and request their reversal.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 8, 2005

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